

REMARKS/ARGUMENTS

Responsive to the Office Action mailed June 17, 2009:

1. The claims have been amended for clarity considerations. For instance, it has been harmonized along Claim 1 to use the expression *selection or reselection parameter*, and not sometimes *selection and reselection parameter*.

As each cell has its selection or reselection parameter(s), the preamble of Claim 1 has been amended to indicate that a geographical sizing of each cell depends on at least one selection or reselection parameter.

Other formal amendments have been made along the claims.

2. Claims 5 to 10 have been withdrawn. We can note that there is no support in the specification about *simultaneously* presetting the parameters.

3. New Claims 11 and 12 have been added. Claim 11 is directed to a testing method inline with the test system of Claim 1. Claim 12 is directed to a determining method for determining a configuration of a mobile telephony network.

4. Claim 1 has been amended to specify that each mobile test telephone is *adapted to select a server cell among plural cells at a given location, said server cell being selected on the basis of the selection or reselection parameters of said plural cells stored by the at least one mobile test telephone*.

Support for this amendment can be found at page 5, lines 1 to 11.

In order to conform the amendment above, Claim 1 has been further amended to indicate that, in the normal mode, the parameters received from the mobile telephony network *are stored* by the mobile test telephone(s) and, in the preset mode, the parameters received from the onboard computer *are stored* by the mobile test telephone(s).

Indeed, the mobile test telephone(s) applies the reselection algorithm on the stored values of selection or reselection parameter, these stored values can be either received from the mobile telephony network or from the onboard computer, and in this case, any parameter received from the mobile telephony network is overwritten by the corresponding parameter received from the onboard computer. One may refer to the specification at page 7, lines 17 to 23.

Claim 1 has been further amended to indicate that *the onboard computer further comprises means for transferring to each mobile test telephone in preset mode predefined values of selection or reselection parameter corresponding to said plural cells*.

One may refer to the specification at page 8, lines 23 to 30: the server cell and neighboring cells are identified and each time a new cell is detected, the onboard computer sends the parameters to the mobile test telephone(s).

5. Claim 2 has been amended to clarify that the GPS unit is used for determining the *given location*, as introduced in Claim 1. One may refer to the specification, at page 7, lines 26-29.

6. Claim 12 is based on the steps of Claim 11, which is the method claim corresponding to Claim 1. One may refer to the same passages of specification. Claim 12 further specifies that *the configuration of the telephony network is determined on the basis of signal reception level values determined by the at least one mobile test telephone for various predefined values of selection or reselection parameter*.

One may refer to the specification at page 10, lines 9 to 11.

7. Considering the cited prior art, neither Sant nor Cheng describes or suggests that *each mobile test telephone is adapted to select a server cell among plural cells at a given location, said server cell being selected on the basis of the selection or reselection parameters of said plural cells*, as specified in independent Claims 1, 11 and 12.

Indeed, Sant describes a mechanism to compare services provided by different telephony networks, but doesn't deal with the selection of any cell.

In addition, Cheng describes a mechanism for implementing a link balance measurement. To do so, Cheng teaches using attenuators in the test mobile telephone in order to simulate an increase of the cell size. However, Cheng doesn't specifically describe the server cell being selected on the basis of the selection or reselection parameters of said plural cells.

Moreover, neither Sant nor Cheng describes or suggests that the predefined values of selection or reselection parameters received from the onboard computer overwrite the values of the selection or reselection parameters received from the mobile telephony network.

Indeed, despite it may interpreted that Sant discloses that parameter overwriting occurs, this overwriting doesn't concern the overwriting of parameters that are normally received from the mobile telephony network, and that are used for defining a geographical sizing of each cell.

Even though Cheng mentions parameters used to simulate an increase in size of the cell, Cheng uses attenuator parameters and not overwriting of the parameters that are normally received from the mobile telephony network.

Even though a combination of Cheng and Sant teachings is attempted by the one ordinary skilled in the art, it would not result in overwriting these particular parameters. Indeed, it would lead to adding attenuator in the mobile test telephone, which involves a more complex design and extra cost compared to the overwriting mechanism of the present invention.

In addition, neither Sant nor Cheng describes or suggests that the onboard computer transfers to each mobile test telephone in preset mode predefined values of selection or reselection parameter corresponding to said plural cells.

Indeed, Sant doesn't deal with such a plurality of cells. Even though Cheng addresses a system with a plurality of cells as shown on Figs. 4, Cheng doesn't disclose that any parameter is preset for this plurality of cells, and more particularly that these parameters are parameters for the selection of the server cell. Indeed, Cheng is only interested in the measurement of the link balance, not with any effective sizing of the cells. Variations of the size of the cell are only considered in the scope of this link balance measurement.

I. PRIOR ART MATTERS

A. The Office Action rejected claims 1-2, 4-10 under 35 USC 103(a) as being unpatentable over Sant in view of Cheng..

The Manual of Patent Examining Procedure 2142 states:

Legal Concept of *Prima Facie* Obviousness [R-6]

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 **2143** MANUAL OF PATENT EXAMINING PROCEDURE Rev. 6, Sept. 2007 2100-128 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

The MPEP also states:

2143 Examples of Basic Requirements of a *Prima Facie* Case of Obviousness

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*. The key to supporting any rejection under 35 U.S.C. **103** is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. **103** should be made explicit.

The Office Action's 'articulated reasons' are:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Sant, and adjust the parameters to modify the geographic sizing of the cell, as taught by Cheng, thereby providing more efficient and accurate link measurements for changes in system configuration, as discussed by Cheng (col. 2 lines 35-45).

2143.02 Reasonable Expectation of Success Is Required [R-6]

A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007);

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

1. The cited prior art does not teach, show or suggest all the claim limitations were known.

As to claims 1, 11 and 12, the cited prior art does not disclose:

Each mobile test telephone is adapted to select a server cell among plural cells at a given location, said server cell being selected on the basis of the selection or restriction parameters of said plural cells...

the predefined values of selection or reselection parameters overwriting the values of the selection or reselection parameters received from the mobile-telephony network...

wherein the onboard computer further comprises means for transferring to each mobile test telephone in preset mode predefined values of selection or reselection parameter corresponding to said plural cell.

See the above arguments for discussion of the failure of the prior art to disclose these claimed limitations.

2. The Office Action has not provided a suggestion or motivation to combine the cited references.

MPEP 2143.01 further states :

I. Suggestion or Motivation To Modify the References [R-6]

PRIOR ART SUGGESTION OF THE DESIRABILITY OF THE CLAIMED INVENTION

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching test as a guard against using hindsight in an obviousness analysis).

There is no teaching, suggestion, or motivation to combine Sant and Cheng to make applicant's claimed invention. That is, the references do not have the claimed elements and limitations above.

Although evidence of a motivation to combine need not be found in the prior art reference themselves, if it is found in the knowledge of one of ordinary skill in the art or, in some cases, from the nature of the problem to be solved, the Office Action must do more than simply discuss the ways that the multiple prior art references can be combined to read on the claimed invention. Rather, the Office Action must point out "specific information in [the two references] that suggest the combination."¹ "The Board [must] explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination."²

In *KSR Int'l Co. v. Teleflex Inc. et.al.*³, the Court re-affirmed that:

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.⁴

¹ See *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1366, 80 USPQ2d 1641, ___ (Fed. Cir. 2006) (citing *In re Dembicza*k, 175 F.3d 994, 999-1000 (Fed. Cir. 1999))

² *Id.* at 1367 (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998))

³ *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727. 82 USPQ2d 1385 (2007)

⁴ *Id.*

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.⁵

The Office Action has not articulated how one skilled in the art of making Applicant's claimed invention would look to prior art comprising Sant and Cheng, as claimed, as obvious.

Rather, the Office Action draws a conclusion in saying that a *prima facie* case of obviousness has been made.

A *prima facie* case of Obviousness has not been shown. Applicant's claims, with significant structure and/or steps claimed, are not shown in the prior art and therefore, are not obvious and the Office Action has not met its required burden.

II. FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED MAY NOT BE SUFFICIENT TO ESTABLISH PRIMA FACIE

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007)(“If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

Inventing Applicant's invention is not predictable from a combination of Sant and Cheng.

III. MERE STATEMENT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art” at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to

⁵ Id.

establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Office Action has not made a *prima facie* case of obvious to one of ordinary skill in the art. Rather, the Examiner states:

It would have been obvious to one skilled in the art to one of ordinary skill in the art at the time the invention was made to modify the invention of Sant...as taught by Cheng.

The Office Action's conclusionary statements are not sufficient to establish a *prima facie* case of obviousness.

IV. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Modifications and combinations of Sant and Cheng to make applicant's claimed invention would change the principle of operation of the these prior art references.

For example, Sant would need to be modified to rely on the selection or reselection parameters supplied by an onboard computer, rather than relying on transmission of voice and data calls to a central location and measuring call quality based on returned messages. This would be an entirely different principle of operation, as Applicant's claimed invention is autonomous (see pp. 3-4 if the Specification) and does not rely on transmission to a central location. Cheng would have to be modified to overwrite parameters normally received from the mobile telephony network to simulate the size of a cell, rather than using attenuation parameters. Furthermore, Cheng applies to CDMA networks and would not be operable, as disclosed, on GSM networks, as discussed in Applicant's Specification and claimed (see pp. 5-6 of Applicant's Specification).

There simply is no evidence or suggestion in the cited references of applicant's claimed configuration. *Ex Parte Katoh et al.*, Appeal 20071460, Decided May 29, 2007.

The Office Action has not provided a sufficient reason or explicit analysis of why the disclosures of the references should be combined. *Ex Parte Erkey et al.*, Appeal 20071375, Decided May 11, 2007.

There is no suggestion to combine the teachings and suggestions of ___, as advanced by the Examiner, except from using Appellants' invention as a template through a hindsight reconstruction of Appellants' claims. *Ex Parte Crawford et al.*, Appeal 20062429, Decided May 30, 2007.

A. The Examiner has not applied the test of *Graham v. John Deere Co.*⁶. The MPEP requires the Examiner to do so.⁷ However, the Examiner has made no finding of the level of ordinary skill in the art.⁸

The Federal Circuit routinely vacates conclusions of obviousness when the fact finder failed to make *Graham* factor findings.⁹ This is especially so when the fact finder makes conclusory statements that “do not fulfill the agency’s obligation’ to explain all material facts relating to a motivation to combine.”¹⁰

The Supreme Court has re-affirmed this need:

Often, it will be necessary for a court to look to...the background knowledge possessed by a person of ordinary skill in the art...in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.¹¹

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

⁶ 383 U.S. 1 (1966)

⁷ MPEP § 2141

⁸ MPEP § 2141.03

⁹ *Dystar*, 464 F.3d 1366 and cases cited therein.

¹⁰ *Id.*

¹¹ KSR, 550 U.S. ____ (2007)

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 02-3732.

Respectfully submitted,

Dated: 6 Apr 11 By Gerald E. Helget

Gerald E. Helget (Reg. No. 30,948)

Nelson R. Capes (Reg. No. 37,106)

BRIGGS AND MORGAN, P.A.

2200 IDS Center, 80 South Eighth Street

Minneapolis, MN 55402

Telephone: 612-977-8480

Facsimile: 612-977-8650